

REMARKS/ARGUMENTS

Reconsideration of this application, in view of the following remarks and arguments, is respectfully requested.

Claims 36-65 are currently pending in this application, and the Examiner's allowance of Claims 38, 45-48, 56-58, 62 and 63 is noted with appreciation. In his October 21, 2004 Office Action, the Examiner made the following claim rejections which are respectfully traversed for reasons subsequently set forth herein.

1. Claims 64 and 65 currently stand rejected under 35 USC §112, second paragraph, as being indefinite;
2. Claims 36, 37, 39-44, 49, 52-55, 59, 64 and 65 currently stand rejected under 35 USC §102(e) as being anticipated by or, in the alternative, under 35 USC §103(a) as being obvious over U.S. Patent 6,279,658 to Donovan et al; and
3. Claims 50, 51, 60 and 61 currently stand rejected under 35 USC §103(a) as being unpatentable over Donovan et al.

Applicant's invention, as set forth in his currently rejected claims, includes the extension of **separate** production and storage wellbores into the **same** subterranean gas formation, using the separate storage wellbore to inject gas into the storage formation, and using the separate production wellbore to withdraw gas from the storage formation. This claimed invention is in sharp contrast to the conventional approach of injecting gas into, and withdrawing gas from, a storage formation, with a **single** tubing string being used for **both** the injecting and withdrawing operations. As discussed in the present applicant's specification (see page 2, line 14 through page 3, line 7), this conventional approach causes several problems, to the solution of which the present invention is directed.

The basis of the examiner's indefiniteness rejection of Claims 64 and 65 is their use of the phrases "utilizing the production wellbore during substantially all periods of usage thereof, only to withdraw gas from the formation", and "utilizing the injection wellbore, during substantially all periods of usage thereof, only to inject gas into the formation".

The examiner states that (1) the term "utilizing" is not a proper method step, and (2) the recitation of "during substantially all periods of usage thereof" is merely a desired course of action. He further states that one may "utilize" one or another wellbore for injecting gas and "utilize" one or another wellbore for withdrawing gas, and therefore the metes and bounds of the language of Claims 64 and 65 cannot be ascertained.

These statements by the Examiner are clearly incorrect. The term "utilizing" is a common, long-accepted method claim step. The recitation of "during substantially all periods of usage thereof" (as to either the injection or production wellbore) is not merely a "desired" course of action, but a **positive** method claim limitation **requiring** that the injection wellbore be dedicated to an injection use, and that the production wellbore be dedicated to a production use. If the same subterranean gas storage formation has both injection and production wellbores run thereto, and, for example, the production wellbore was used to both inject and produce, this limitation would not be met - the production wellbore would not be utilized during substantially all periods of usage thereof to withdraw gas from the formation. It is thus respectfully submitted that neither of applicant's Claims 64 and 65 is in any manner indefinite, and that the Examiner's indefiniteness rejection of such claims should be withdrawn.

Turning to the anticipation and obviousness rejection of Claims 36, 37, 39-44, 49-55, 59-61, 64 and 65, via independent Claims 36, 52, 64 and 65, each of these claims, in one manner or another, specifies the extension of **separate** production and storage wellbores into the **same** subterranean formation.

The examiner contends that the wellbores 20b', 20b'', 20b''', or any of 20 shown in FIG. 2 of Donovan et al extend into the **same** formation, stating that "The formation into which any or all of 20a, 20n, and 20b (including 20b', 20b'', and 20b''') extend forms a **single** formation."

However, there is no disclosure whatever in Donovan et al that any two of these depicted wellbores are extended to the **same** subterranean formation. Instead, the Donovan et al specification is replete with statements indicating that the indicated wellbores go to **different** subterranean formations. For example, it is stated beginning at column 3, line 36 in the Donovan et al specification, that "A plurality of branch wellbores are formed from the main wellbore into **reservoirs** for producing hydrocarbons therefrom". Other similar indications in Donovan et al that the indicated wellbores are extended to **different** reservoirs may be found at the following locations in the Donovan et al specification:

1. Column 5, line 65;
2. Column 12, line 63;
3. Column 13, line 21;
4. Column 14, line 8;
5. Column 15, line 18; and
6. Column 16, line 9.

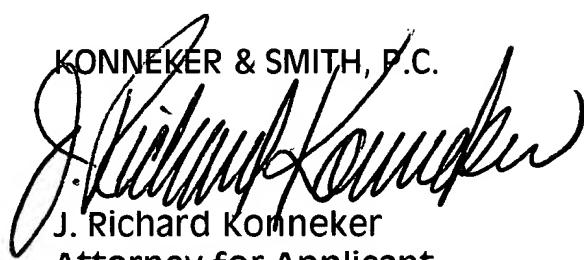
With these different wellbores being run to different subterranean formations, the Donovan et al reference merely illustrates the prior art approach of using the same wellbore to both produce from and inject into the same formation. It is the problems associated with this conventional injection/production technique that the present applicant's uniquely different claimed invention addresses.

In view of the foregoing remarks and arguments, all of the claims currently pending in this application are now seen to be in a condition for allowance. A Notice of Allowance of Claims 36-65 is therefore earnestly solicited.

The Examiner is hereby requested to telephone the undersigned attorney of record at 972/516-0030 if such would further or expedite the prosecution of the instant application.

Respectfully submitted,

KONNEKER & SMITH, P.C.



J. Richard Konneker
Attorney for Applicant
Registration No. 28,867

Dated: November 8, 2004

660 N. Central Expwy., #230
Plano, Texas 75074
972/516-0030

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450,

on November 8, 2004
Diane Sutton